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Supreme Court of the United States

OCTOBER TERM, 1942.

No. 515

F. A. SMITH MANUFACTURING CO., INC.,
Petitioner,

vs.

SAMSON-UNITED CORPORATION,
Respondent.

**BRIEF FOR RESPONDENT IN OPPOSITION
TO PETITION FOR CERTIORARI**

W. B. MORTON,
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The decision sought to be reviewed by this petition is the third decision of the Circuit Court of Appeals for the Second Circuit sustaining the patent in suit as valid and infringed. The three appeals were from three different districts in the same Circuit and each of the District Judges also held the patent in suit to be valid. In the two earlier cases the District Judges held the patent not infringed by the particular fans there in issue but in each instance were reversed by the Court of Appeals which specifically held the patent to cover a meritorious invention and to be entitled to reasonably broad construction.*

In the case at bar the District Court also held the patent infringed and the Court of Appeals in affirming that deci-

*Samson-United Corp. vs. Emanuel et al, 109 F. (2d) 922, 923.

sion held: "The accused fan is to all intents and purposes a copy of the assembled patented fan" (R. II, 522). They then went on to say: "There is no difference at all in the fans patentwise. * * * Merely to mold in one piece what the patentee elected to assemble from more than one was but to substitute an obvious equivalent for what the specifications disclosed" (R. II, 522).

There would seem to be no such conflict in the decisions of the lower courts as to require a review by this Court of the decision in the case at bar.

The Questions Presented

The questions presented by this case are the usual questions presented by every patent case:

- (1) The novelty and utility of the patented structure over the prior art.
- (2) Whether the accused structure presents such departures from the specific structure of the patent as to be without the scope of the patent.

The statement of "the questions presented" by the petitioner (Petition pp. 6-8) makes it plain that, aside from an alleged question of evidence (Question 6), the case presents nothing more than this necessary comparison of the prior art structure, the patented structure and the accused structure. Question 6 (Petition, p. 8) purports to find a question of estoppel presented by the comment of the court in its opinion on the inconsistency between the actions of a pleaded prior inventor at the time of his alleged invention and his claim of inventorship made for the first time in this suit. It is obvious from the opinion that no question of estoppel is presented. The Court merely, as it said, took into consideration the conduct of the witness in weighing his testimony and decided that the allegation of prior inventorship was not proven.

Reasons Relied Upon for the Granting of the Writ

The alleged reasons for granting the writ find no basis in the facts presented by the record.

1. The opinion of the Court of Appeals presents no conflict with the opinion of this Court in *Schriber-Schroth Co. vs. Cleveland Trust Co.*, 305 U. S. 47-57. In that case this Court held the patent in suit had been broadened by amendment, unlawfully added. No such question is presented here. In fact no transcript of the Patent Office proceedings in the application for the patent here in suit is included in the record. The Court of Appeals in the case at bar specifically found "no difference at all * * * patent-wise" between the fan of the patent and the accused fan (R. II, 522). It requires no "enlargement" of a patent to hold it infringed by a substantially identical structure.

2. There is no foundation for petitioner's contention that the fan industry is in any way limited to the Second Circuit. In the *Tri-Ergon* case this Court granted certiorari on a showing that practically the entire motion picture industry was subject to the jurisdiction of the New York courts, and in *Schriber-Schroth Company vs. Cleveland Trust Co. supra*, this Court took judicial notice of the fact that the automobile industry is largely centered in the Sixth Circuit.

The Court may very well take judicial notice of the fact that there is no such centralization of the fan industry. The particular infringer in the case at bar happens to be located in the same city as plaintiff—Rochester, N. Y., but there is no centralization of fan manufacture in that city. In fact all the larger manufacturers of fans are located elsewhere, for the most part in different circuits.

3. There is no conflict between the decision of the Court of Appeals in the case at bar with the decisions of this Court in *Cuno Corp. vs. Automatic Devices Corp.*, 314 U. S. 84; *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corporation*, 294 U. S. 477, and *Florsheim v. Schilling*, 137 U. S. 64.

In the *Cuno* case, this Court held that the addition to an old electric cigar lighter of a thermostatic switch previously used for the same purpose in electric heaters, toasters and irons, was not invention (314 U. S. 84, 91).

In the *Tri-Ergon* case "no invention" was found in the addition to an old driving gear arrangement of a flywheel for its recognized purpose of maintaining uniform motion.

In the *Florsheim* case, the decision of the Court is summarized in the following paragraph:

"In the light of the authorities, our judgment is that the appellants' patent No. 238,100 was for a corset that had been in long and publicly known use, each part of it previously patented; that it involved nothing original in the construction of those parts nor in their relation to one another, nor any change in the function of any one of them; and that the combination of them produced no original mechanism or device."

The Court of Appeals of the Second Circuit in its second decision dealing with the patent here in suit, *Samson-United Corporation v. Emanuel*, 109 F. (2d) 922, 923, thus summarized the patentee's accomplishment:

"What he [the patentee] did was to take a well-known type of fan; make its blades of a well-known material; shape them as metal had been shaped for fan blades and in doing so preserved a sufficient amount of the natural pliability of the material to keep the blades practically harmless in operation while adding sufficient stiffness to them to make them effi-

cient in use. Though the change from the old was structurally slight, it was great in terms of accomplishment.”*

4. As we have pointed out above, there is no question of estoppel presented by this case. The situation is merely the familiar one where courts have properly given weight to the former words and deeds of the witness at the time of the event, which are inconsistent with his present contentions. The mechanic Humphreys who now comes forward with a claim of inventorship, and his immediate employers, the K-W Ignition Corp., fully recognized at the time they were making the experimental models of the patented fan that the invention they were engaged to develop was that of Samuels. In answer to a letter (R. II, 340, 341) written by Samuels to the K-W Ignition Corp. while this work was going on (Deft's. Exh. 11, R. II, 340) wherein he requested that the development with respect to “my invention” be kept “strictly confidential,” (this was before the application for patent was filed), that company, by its Vice President who had charge of the matter, replied (R. II, 342):

“Also please rest assured that any idea which you may talk over with us or which we may assist in developing will be treated with exactly as much confidence, if not more so, as though you were doing it in your own plant as, of course, we feel an obligation to merit the confidence placed in us by our customers as though it were something of our own that we were bringing out for our own distribution.”

The Court of Appeals very properly held that the present totally inconsistent claim of Humphreys to be the original inventor had to be established by evidence of more weight than anything presented in this record.

*The Gilbert fan patent, on which the petitioner mainly relies, was also the principal reliance of the defendant in the Emanuel case (R. II, 522, last sentence).

The petitioner concludes its argument with the request that this Court give careful consideration to the dissenting opinion of Judge Frank. Judge Frank was appointed to the Court after the decisions were rendered in the first two cases involving the patent in suit. Since he had not seen the records in those cases, which are not in evidence here, he apparently reviewed the records before writing his dissenting opinion. He found what he felt was an inconsistency between the testimony of the patentee in the former cases and the present case. Judge Frank overlooked the fact that in the earlier cases no claim of prior inventorship on the part of Humphreys or the K-W Ignition Corp. was presented. The patentee testified briefly as to the development of the invention, and in doing so quite naturally made no distinction between the experimental fans which he himself had made before his contact with the K-W Ignition Corp. and the later ones made by that corporation for Samuels' company.

Conclusion

The Circuit Court of Appeals for the Second Circuit has in several of its recent opinions expressed itself as mindful of the fact that this Court has set a higher standard of invention than formerly required.

Picard v. United Aircraft Corporation, 128 F. (2d) 632, 636.

The invention of the patent in suit has been held to conform with that higher standard, and the decision of the Court of Appeals of the Second Circuit in sustaining the patent for the third time as valid and infringed presents no conflict with any decision of this Court.

Respectfully submitted,

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